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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,349	10/20/2003	Bradley S. Schlachter		3456

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EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT PAPER NUMBER

3727

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/689,349	SCHLACHTER, BRADLEY S.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Justin M. Larson	3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the bracket of claims 5 and 11, used to secure the rear wheel to the second support surface, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

3. Claims 12-16 and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 12 and 21, each claim first introduces a vehicle having particular surfaces and then states that an improvement comprises a particular mounting structure attached to the vehicle. As currently presented, Examiner is unsure of the metes and bounds of the claims, as they could be interpreted as claiming either of the following:

A) The combination of a vehicle and a mounting structure.

B) An improvement on a vehicle, the improvement comprising a mounting structure, but not necessarily in combination with the vehicle.

Regarding claims 13-16 and 22, the claims are rendered unclear and indefinite for depending on and including the subject matter of claims 12 and 21.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 5, 6, 12, 13, 17, 21, 22, are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al. (US 5,476,201).

Regarding claim 1, Hall et al. discloses a system comprising: a support member (44) and a mount (46) attachable to the support member.

Regarding the remaining limitations of the claim, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Hall et al. which is capable of being used in the intended manner, i.e., the system being used in conjunction with a vehicle and a bicycle; the vehicle having a first support surface extending in a plane, and a second support surface; the bicycle having a fork in which a wheel is normally mounted, and an opposing wheel; wherein the support member is secured to the first support surface of the vehicle; and the mount is attachable to the support member and is adapted to receive and secure the fork of the bicycle for rotation about an axis extending through the mount such that, with the fork secured to the mount, the bicycle is positioned at a given angle relative to the plane of the first support surface with the opposing wheel of the bicycle being located on or adjacent the second support surface. There is no structure in Hall et al. that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 2, Hall et al. further discloses a component (42) that secures the opposing wheel of the bicycle to the second support surface.

Regarding claim 5, because the claimed bracket is not shown in Applicant's drawings and no particular structure is defined in the disclosure, Examiner is considering the component (42) of Hall et al. to be a bracket.

Regarding claim 6, the mount of Hall et al. has a mechanism (56) that can be released as quickly as a user can turn it, and if turned quickly, is effectively a quick release mechanism.

Regarding claim 12, because the claim positively recites the support member being secured to the first support surface of the vehicle, Examiner assumes that the claim is intended to claim the combination of the vehicle itself along with the particular mounting structure of the present invention. To this degree, Hall et al. discloses a vehicle having a first support surface (14) extending in a plane, and a second support surface (72) located in a plane substantially parallel to and below the plane of the first support surface, a single support member (44) secured to the first support surface; and a mount (46).

Regarding the remaining limitations of the claim, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Hall et al. which is capable of being used in the intended manner, i.e., the mount being attachable to the single support member and adapted to receive and secure a fork of a bicycle for rotation about an axis extending through the mount such that an opposing wheel of the bicycle is capable of being positioned adjacent the second support surface. There is no structure in Hall et al. that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 13, Hall et al. further discloses a component (42) that secures the opposing wheel of the bicycle to the second support surface.

Regarding claim 17, Hall et al. discloses a vehicle having a roof extending in a plane, the roof having a front edge and a rear edge, comprising: a single support member (44) and a mount (46).

Regarding the remaining limitations of the claim, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Hall et al. which is capable of being used in the intended manner, i.e. the support member being adapted to be secured across the roof at or adjacent the rear edge; and the mount being adapted to receive and secure a first portion of an article for rotation about an axis extending through the mount such that, with the first portion of the article secured to the mount, the article is positioned at a given downward angle relative to the plane of the roof with the opposing wheel of the bicycle being located on or adjacent the second support surface of the vehicle. There is no structure in Hall et al. that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 21, because the claim does not positively recite the support member being secured to the first support surface of the vehicle, Examiner assumes that the claim is intended to claim the subcombination of the particular mounting structure of the present invention. To this degree, Hall et al. discloses a mount (46) and a component (42) that secures the opposing wheel of the bicycle to the second support surface.

Regarding the remaining limitations of the claim, the initial statement of intended use and all other functional implications have been carefully considered but are deemed

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not to impose any patentably distinguishing structure over that disclosed by Hall et al. which is capable of being used in the intended manner, i.e., the mount being attachable to the single support member and adapted to receive and secure a fork of a bicycle for rotation about an axis extending through the mount such that an opposing wheel of the bicycle is capable of being positioned adjacent the second support surface. There is no structure in Hall et al. that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 22, the mount of Hall et al. is a fork mount and the portion of the bicycle is a fork.

6. Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ackerman et al. (US 5,749,694).

Regarding claim 7, Ackerman et al. discloses a bicycle carrier system, the system consisting essentially of a single support member (48), a mount (24), and a component (26).

Regarding the remaining limitations of the claim, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Ackerman et al. which is capable of being used in the intended manner, i.e., the system being used in conjunction with a vehicle and a bicycle; the vehicle having a first support surface extending in a plane, and a second support surface; the bicycle having a fork in which a wheel is normally mounted, and an opposing wheel; wherein the support member is adapted to be secured to the first support surface of the vehicle; and the



mount is attachable to the single support member and adapted to receive and secure the fork of the bicycle for rotation about an axis extending through the mount such that, with the fork secured to the mount, the bicycle is positioned at a given angle relative to the plane of the first support surface with the opposing wheel of the bicycle being located on or adjacent the second support surface. There is no structure in Ackerman et al. that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 8, the mount of Ackerman et al. includes a quick release mechanism (74).

Regarding claims 9 and 10 the component of Ackerman et al. can be considered to be the strap or flexible cord (80) that secures the rear wheel of the bicycle to a supporting surface.

Regarding claim 11, the component (26) of Ackerman et al. can be considered to be a bracket since the claimed bracket has not been shown in Applicant's drawings and its structure has not been defined in the disclosure.

7. Claims 12, 15, 16, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sokn (US 5,037,019).

Regarding claims 12, Sokn discloses a vehicle having a first support surface (2) extending in a plane, and a second support surface (1) located in a plane substantially parallel to and below the plane of the first support surface, a single support member (9) secured to the first support surface; and a mount (26).

Regarding the remaining limitations of the claim, the initial statement of intended use and all other functional implications have been carefully considered but

are deemed not to impose any patentably distinguishing structure over that disclosed by Sokn which is capable of being used in the intended manner, i.e., the mount being attachable to the single support member and adapted to receive and secure a fork of a bicycle for rotation about an axis extending through the mount such that an opposing wheel of the bicycle is capable of being positioned adjacent the second support surface. There is no structure in Sokn that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 15, the first support surface (2) of Sokn is a side rail of the vehicle and the second support surface (1) is a bed.

Regarding claim 16, the bicycle of Sokn is positioned across the bed of the truck.

Regarding claim 18, Sokn discloses a vehicle having a side rail (2) extending in a plane, and a storage bed extending in a plane substantially parallel to and below the plane of the side rail, comprising: a single support member (9) and a mount (26).

Regarding the remaining limitations of the claim, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Sokn which is capable of being used in the intended manner, i.e. the support member being adapted to be secured along the side rail; and the mount being attachable to the single support member adapted to receive and secure a first portion of an article for rotation about an axis extending through the mount such that, with the first portion of the article secured to the mount, the article is positioned at a given downward angle relative to the plane of the side rail with a second portion of the article located on or adjacent the

storage bed. There is no structure in Sokn that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 20, the article of Sokn is a bicycle.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al. as applied to claim 1 above in view of Ackerman et al. Hall et al. discloses the claimed invention except for the component being a strap or flexible cord.

Ackerman et al., however, discloses a bicycle mount system where a mounting member supports the fork of the bicycle on a first portion of a vehicle surface and a component secure the rear wheel of the bicycle to another portion of the vehicle surface. Ackerman et al. teaches that the component utilizes a strap or flexible cord (80) to secure the rear wheel of the bicycle in place. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the component of Hall et al., by using a strap or flexible cord, as taught by Ackerman et al., in order to better secure the rear wheel of the bicycle to the support surface of the vehicle.

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10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al. as applied to claim 12 above in view of Moore (US 6,454,149). Hall et al. discloses the claimed invention except for the second support surface being a bed.

Moore, however, teaches that it is known in the art to secure an elongated article at an angle on a pickup truck, supporting a first end of the article on the roof of the truck and resting the second end of the article in the bed of a pickup truck. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the system of Hall et al. in a pickup truck, as taught by Moore, allowing a user who owned a truck rather than a car to conveniently carrying a bicycle on their vehicle.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sokn. Sokn discloses the claimed invention except for the given downward angle being approximately 45 degrees. Examiner takes the position that the angle shown by Sokn is merely a result of the height of the truck's cab and/or the length of the bicycle, the height of the cab effectively determining the height at which the side rail is located and ultimately the height at which the support member is mounted. Basically, the angle at which the bicycle, or other article, is held is not unique to the structure of the present invention, but, rather, to the structure of the vehicle, particularly the bed of the truck. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the mounting system of Sokn on a truck with a deeper truck bed, effectively increasing the angle at which the bicycle is held, such as approximately 45 degrees. Also, one of ordinary skill might choose to store a kid's bicycle on the carrier, and being much shorter than the bicycle shown by Sokn, the bicycle would be held at a

higher angle, such as approximately 45 degrees, effectively satisfying the limitations of the claim.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Friday, 8am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JML  
1/9/06

  
**NATHAN J. NEWHOUSE**  
**SUPERVISORY PATENT EXAMINER**